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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,282	10/07/2003	Christopher R. Vincent	POU920030115US1	7369

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EXAMINER	
LY, CHEYNE D	

ART UNIT	PAPER NUMBER
2168	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/680,282	VINCENT, CHRISTOPHER R.	
	Examiner	Art Unit	
	Cheyne D. Ly	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/07/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 are examined on the merits.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. In regard to claims 1-18, the claimed invention does not result in a physical transformation, or produce a useful, tangible, and concrete result. For example, claim 1, recites the last step of "using..." for the intended step of "execute the source code..." However, the intended step does not actually get executed; therefore, produce a useful, tangible, and concrete result is produced.

5. Claims 7-10 fail to place the invention squarely within one statutory class of invention. On page 18, lines 20-24 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals such as wireless network. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

6. In regard to claim 11, 12, and 16-18, the claimed control or customer support application has been interpreted as merely software per se. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.
7. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)
8. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

CLAIM REJECTIONS - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5-8, 10-14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrmann (US 5,995,756A).

11. In regard to claim 1, Herrmann discloses a method for providing support to a user from a remote computer, the method comprising:

activating a control embedded in a web page that is currently being viewed by a web browser (column 7, lines 58-60, "from within a browser, a user would select a Web page link…invoke a particular frame of the application" for example);

receiving source code from the remote computer (column 8, lines 37-38, download the program code"); and

using the control to execute the source code received from the remote computer so as to read and/or modify state information of the web browser (column 8, line 63, to column 9, line 3).

12. In regard to claim 2, Herrmann discloses the state information of the web browser includes form information entered into at least one form field of the web page that is currently being viewed by the web browser (column 9, lines 6-11, "user can interact with the form", and column 9, lines 29-32, "HTML forms that are intended to send data to a server-based application" for example).

13. In regard to claim 3, Herrmann discloses the using step includes the sub-steps of: executing the source code so as to read the form information; and sending the form information that is read to the remote computer (column 9, lines 29-32, "HTML forms that are intended to send data to a server-based application" for example).

14. In regard to claim 5, Herrmann discloses after the activation step and before the receiving step, sending a message from the control to the remote computer to establish a connection between the control and a support application executing on the remote computer (column 7, lines 58-60, "from within a browser, a user would select a Web page link...invoke a particular frame of the application" for example).

15. In regard to claim 6, Herrmann discloses the using step includes the sub-step of executing the source code so as to cause the web browser to view a different web page (column 11, lines 41-44, "create a view...attached to a user-interface frame (in this case, the web browser)").

16. In regard to claims 7, 8, 10, 11-14, 16, and 17, Herrmann discloses the claimed invention as cited above.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 4, 9, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann (US 5,995,756A) as applied to claims 1-3, 5-8, 10-14, 16, and 17 above, and further in view of Lee (US 20030146937 A1).

MOTIVATION TO COMBINE

19. Lee describes an improvement to provide a platform that allows application designers to design different user interfaces and meet various application requirements in a faster and more efficient manner (page 1, [0006]). Herrmann describes a form-based development environment for partitioning an application such that it can be seamlessly integrated into corporate Webs (column 3, lines 22-26), and an improvement to provide a centralized repository for program code with the ability to keep code up to date (column 3, lines 9-19). One of ordinary skill in the art at the time of the invention would have been motivate by Lee the improve the method of Herrmann to provide a platform that allows application designers to design different user interfaces and meet various application requirements in a faster and more efficient manner.

BASIS FOR PRIOR

20. In regard to claims 4, 9, 15, and 18, Herrmann describes the claimed invention as cited above. However, Herrmann does not describe the limitation of modify at least one form field. Lee describes the limitation of modify at least one form field (page 12, [0069], "modify the form field" for example). Therefore, it would have been obvious for one of ordinary skill in the art to use the invention described by Herrmann with the modification of the form field as described by Lee to allow application designers to design different

user interfaces and meet various application requirements in a faster and more efficient manner.

CONCLUSION

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sullivan et al. (US 6,477,531B1) and Savage (US 2004/0054968A1).

22. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

23. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly
Patent Examiner
6/15/07